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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,002	12/12/2000	Motoharu Seiki	2000-1617	6487

7590 01/14/2004

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EXAMINER

CANELLA, KAREN A

ART UNIT PAPER NUMBER

1642

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/734,002	SEIKI ET AL.	
	Examiner	Art Unit	
	Karen A Canella	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 36-38, 41-49 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 47 and 48 is/are allowed.
- 6) ☐ Claim(s) 36-38, 41-46, 49, 51-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-35, 39, 40 and 50 are canceled.
2. The text of title 35 US Code not found in this action can be found in a previous Office action.
3. Claims 36-38, 41-46, 49 and 51-53 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated antibody which specifically binds to a matrix metalloproteinase of a salt thereof, and methods of producing an antibody which specifically binds to a matrix metalloproteinase or salt thereof, does not reasonably provide enablement for an isolated antibody which binds to a protein which comprises a fragment of SEQ ID NO:2, or a method of making an antibody which binds to a protein comprising a fragment of SEQ ID NO:2. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Claim 1 is drawn in part to an isolated antibody which binds to a partial peptide of contiguous antigenic residues of SEQ ID NO:2. The claim encompasses any antibody which binds to an epitope present on SEQ ID NO:2 and is not limited to antibodies which bind to matrix metalloproteinases. The claim thus encompasses antibodies which cross react with other proteins which minimally comprise an epitope of SEQ ID NO:2. Further, claim 1 is drawn to a partial peptide which comprises rather than consists of antigenic residues of SEQ ID NO:2. Antibodies which bind to said partial peptide which comprises contiguous antigenic residues of SEQ ID NO:2 are not confined to antibodies which only bind to the contiguous antigenic residues of SEQ ID NO:2. Claims 45 and 46 are drawn in part to methods for producing an antibody by the immunizing an animal with a partial peptide of a matrix metalloproteinase wherein said partial peptide or salt thereof comprises contiguous antigenic residues of SEQ ID NO:2 and can read on antibodies which bind to an epitope in the partial peptide outside of the contiguous antigenic residues of SEQ ID NO:2. The specification teaches only how to use antibodies which specifically bind to the matrix metalloproteinases disclosed. Amendment of claims 36 and 49 to recite "consisting of" rather than "comprising or comprises, and amendment

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of claims 45 and 46 to insert the qualifier of "which specifically binds to a matrix metalloproteinase or salt therefor" after the word antibody in the claim preamble would overcome this rejection. In the event that applicant makes said amendments as suggested by the proposed Examiner's Amendment of January 5, 2003, it will be necessary to cancel claim 51 as a substantial duplicate of claim 49.

4. All other rejections and objections as set forth in the previous Office action are withdrawn in light of applicants amendments and arguments.

Conclusion

Applicant's amendment, deleting the phrase "which are characteristic of said MMP protein" necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308 8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308 3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 0196.

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Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

01/12/04

A handwritten signature in cursive script, reading "Karen A. Canella", followed by a horizontal flourish line.